

Remarks

Claims 1-9 are pending in the application. Reconsideration and allowance of the application are respectfully requested.

The non-final Office Action dated October 16, 2007 lists the following rejections: claims 1-3 and 5-7 stand rejected under 35 U.S.C. § 102(b) over Kato *et al.* (JP 05-343691); and claims 4 and 8-9 stand rejected under 35 U.S.C. § 103(a) over Kato.

Applicant respectfully traverses the § 102(b) rejection of claims 1-3 and 5-7 because the cited portions of the Kato reference do not correspond to the claimed invention which includes, for example, aspects directed to a conductive shield plate that is electrically connected to the source region of the insulated gate field effect transistor. The Office Action erroneously asserts that Kato teaches that electrode 21 is connected to source 12. In actuality, Kato teaches that electrode 21 is connected to drain terminal D (*see, e.g.*, Figure 5 and paragraph 0023), instead of being connected to the source region as in the claimed invention. Applicant notes that the source and drain regions of the claimed invention are not interchangeable. *See, e.g.*, Figure 1. Accordingly, the § 102(b) rejection of claims 1-3 and 5-7 is improper and Applicant requests that it be withdrawn.

Applicant further traverses the § 102(b) rejection of claim 7 because the cited portions of the Kato reference do not correspond to aspects of the claimed invention directed to the shield plate being p-type doped polysilicon. The Office Action improperly asserts that Kato's electrode 21 is p-type doped polysilicon. However, the cited portions of Kato do not mention that electrode 21 is p-type doped polysilicon as is the shield plate of the claimed invention. Accordingly, the § 102(b) rejection of claim 7 is improper and Applicant requests that it be withdrawn.

Applicant respectfully traverses the § 103(a) rejection of claims 4 and 8-9 because the Office Action fails to establish a *prima facie* case of obviousness. The Office Action relies upon improper conclusory statements in asserting obviousness, thereby directly contradicting the U.S.P.T.O. guidelines for maintaining an obviousness rejection under KSR ("Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."). *See KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (U.S. 2007). In this instance, the Office Action

simply concludes that aspects of the claimed invention directed to the dimensions of parts of the field effect transistor would have been obvious because “where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (*In re Aller*, 105 USPQ 233, 1955).”

However, this rationale does not apply because the Kato reference does not disclose any teachings relating to the dimensions of the various aspects of Kato’s device asserted as corresponding to the claimed invention. Thus, the Office Action has not established that Kato teaches any overlapping ranges of dimensions relative to claims 4 and 8-9. *See, e.g.*, M.P.E.P. § 2144.05. As such, Applicant submits that the Office Action fails to establish that the general conditions of the claimed invention are disclosed by the Kato reference.

Moreover, the Office Action has not provided any reason why one of skill in the art would modify Kato’s device to have the dimensions as claimed in claims 4 and 8-9. This approach is contrary to the requirements of § 103 and relevant law. *See, e.g., KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (U.S. 2007) (“A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.”). In this instance, the Office Action fails to provide any evidence as to why one of skill in the art would modify the Kato reference. As noted above, the Kato reference fails to identify any dimensions relative to the portions cited by the Office Action. As best understood by Applicant from the incomplete translation of the Kato reference, Kato appears to have no appreciation for advantages resulting from the various claimed dimensions (*see, e.g.*, claim 9 and paragraph 0023 of Applicant’s specification) or any purpose to conduct any such experimentation towards Applicant’s dimensions. *See, e.g.*, M.P.E.P. § 2144.05. Thus, the skilled artisan would not be motivated to modify the Kato reference in any manner relative to the claimed invention or its attributes. In addition, Applicant submits that, in the absence of a valid reason why the skilled artisan would modify Kato, the Office Action appears to be improperly resorting to hindsight reconstruction based upon Applicant’s disclosure in an attempt to arrive at a combination that corresponds to the claimed invention. *See, e.g.*, M.P.E.P. § 2142.

In view of the above, the Office Action has failed to establish a *prima facie* case of obviousness. Accordingly, the § 103(a) rejection of claims 4 and 8-9 is improper and Applicant requests that it be withdrawn. Moreover, the § 103(a) rejection of claims 4 and 8-9 is improper because the cited portions of the Kato reference do not correspond to the claimed invention as discussed above in relation to the § 102(b) rejection of claim 1.

Applicant further traverses the § 102(b) rejection of claims 1-3 and 5-7 and the § 103(a) rejection of claims 4 and 8-9 (each of which is based upon Kato) because the English translation of the Kato reference provided with the Office Action is insufficient to allow Applicant to determine the propriety of the rejection. According to M.P.E.P. § 706.02, "If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection." Applicant is unable to determine the propriety of the rejection because the provided English translation of Yuji is incomplete and nonsensical. For example, the translation states in relation to Figure 5 (which is relied upon by the Office Action) that "if it carries out like this drawing 5, since the potential of the electrode 21 in a slot 16 will become higher than the gate electrode 18 in drawing 1 -- pressure-proofing -- the field strength of a slot side attachment wall -- not being decided -- p mold -- a well -- a field 11 to n+". In another example, the provided translation contains numerous incomplete sentences. As such, Applicant is unable to ascertain what the Kato reference teaches and is thus unable to determine the propriety of the rejection. *See, e.g.*, M.P.E.P. § 706.02. Therefore, the § 102(b) rejection of claims 1-3 and 5-7 and the § 103(a) rejection of claims 4 and 8-9 are improper and Applicant requests that they be withdrawn. Should any rejection based upon the Kato reference be maintained, Applicant requests a complete and accurate English translation of Kato and an opportunity to respond thereto.

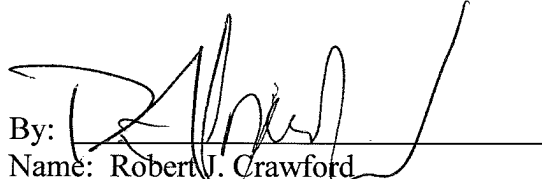
Applicant notes that claim 5 has been amended to include aspects directed to the shield plate trench extending to a depth that is substantially equal to the body depth. The cited portions of the Kato reference teach that slot 16 extends to a depth that is significantly below the depth of field 11. *See, e.g.*, Figure 5. Thus, the cited portions of Kato do not correspond to claim 5. Accordingly, Applicant submits that claim 5 is also allowable over the Kato reference.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063 (or the undersigned).

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